

7/26/01
Hearing:
March 7, 2001

**THIS DISPOSITION
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OF THE T.T.A.B.**

Paper No. 24
TEH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Mayo Foundation for Medical Education and
Research substituted for Mayo Foundation¹

v.
PNS & WSS, Inc.

Opposition No. 110,756
to application Serial No. 75/305,028
filed on June 6, 1997

J. Thomas Vitt of Dorsey & Whitney LLP for Mayo Foundation.

Albert Robin of Robin, Blecker & Daley for PNS & WSS, Inc.

Before Hairston, Wendel and Holtzman, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by PNS & WSS, Inc. to
register the mark CARDIOLOGY TODAY for a "medical newspaper."²

¹ Opposer's consented motion (filed October 27, 2000) to substitute Mayo Foundation for Medical Education and Research as plaintiff in this proceeding is granted.

² Application Serial No. 75/305,028 filed June 6, 1997, alleging a bona fide intention to use the mark in commerce. The word CARDIOLOGY has been disclaimed.

Registration has been opposed by Mayo Foundation. As its ground for opposition, opposer asserts that applicant's mark when applied to applicant's goods so resembles opposer's previously used mark CARDIOLOGY TODAY AND TOMORROW for "educational services, namely, seminars in the field of cardiology" and in connection with "audiovisual and printed materials in the field of cardiology" as to be likely to cause confusion under Section 2(d) of the Trademark Act. Opposer alleges that it has used this mark in connection with the identified goods and services since at least as early as July of 1994, long prior to the June 6, 1997 filing date of applicant's intent-to-use application.

Applicant, in its answer, admits that it made no use of its mark prior to June 6, 1997, and otherwise denies the salient allegations. Applicant affirmatively asserts that opposer "has not acquired any trademark or service mark rights in the unitary mark CARDIOLOGY TODAY AND TOMORROW."

The record includes the pleadings; the file of the involved application; and opposer's notice of reliance on certain of applicant's discovery responses (including certain documents produced by applicant as permitted by stipulation of the parties) and the discovery depositions (with certain exhibits) of three of applicant's witnesses, Richard Roash (applicant's vice president, group publisher), John C. Carter

(publisher of applicant's journal division), and Michael W. LoPresti (applicant's sales director, pharmaceutical group). Opposer has submitted the testimony (with exhibits) of Arnie Bigbee, former administrator for the Mayo School for Continuing Medical Education, and Tamara Kary Erickson, current administrator for the Mayo School for Continuing Medical Education. Applicant did not take any testimony but filed a notice of reliance on other exhibits to the deposition of Mr. Roash, as permitted by stipulation of the parties, and certified copies of the file contents of two registrations and a pending application owned by opposer.

Both parties filed briefs and an oral hearing was held on March 7, 2001.

Opposer, Mayo Foundation, sponsors educational programs and publishes a medical journal for physicians.³ Through its School of Continuing Education, the Mayo Foundation is accredited to provide continuing medical educational (CME) credits by the Accreditation Council for Continuing Medical Education in association with the American Medical Association. One such CME program, directed primarily to cardiologists, is CARDIOLOGY TODAY AND TOMORROW. This is a teleconferenced program which was first provided by opposer in 1995. The program is produced in opposer's studios and it is

then transmitted live, via satellite, to host sites around the country, typically health care centers or universities.

Opposer produces seven to twelve new programs a year under this mark and it registers from 50 to 350 host sites for each program. However, the number of people who actually attend the program is not tracked by opposer. In addition to these host sites, opposer has eight contract sites which in turn rebroadcast the program to anywhere from 200 to 1500 of their own subscribers throughout the country. In addition, opposer conducted at least one external webcast of its program in 1999. According to opposer's program brochure, the registration fee for each program offered in 1999 was \$300 per site in the United States. Individuals who request credit for attending the program pay a \$20 fee. A videotape is produced from the live broadcast and the video, along with an accompanying syllabus and a brochure, may be purchased from opposer for a fee of \$50. Ms. Erickson indicates that several hundred people a year order the videotape which she believes amounts to approximately \$10,000 to \$30,000 per year in sales. Aside from its earliest marketing efforts, opposer advertises this program by a video broadcast on subscription health care channels located at the contract sites, through the website of the School of CME, and, at the beginning of each year, by

³ According to Ms. Erickson, the magazine, entitled *Mayo Proceedings*,

distributing to past participants as well as other interested health care centers "thousands" of brochures (Erickson dep. p.11) containing information on upcoming programs. The program is also promoted at display booths located at other cardiology programs and seminars produced by opposer.

Applicant began operations in 1923 and is, according to the introduction on its website, a "provider of healthcare information [and] education." Applicant publishes periodicals and books in health fields and also sponsors CME seminars for physicians, primarily in the field of ophthalmology.

Applicant launched its medical newspaper under the mark CARDIOLOGY TODAY in October 1997.⁴ According to both Mr. Roash and Mr. Carter, the primary purpose of the newspaper is educational, and its major function is to provide current news and information of particular interest to cardiologists. In addition, the "mission statement" on the CARDIOLOGY TODAY website provides, among other things, that "[e]ach issue will provide timely coverage of major cardiology meetings...." The newspaper is a monthly publication mailed free of charge to all of the approximately 18,000 cardiologists in the United States. An Internet version of the CARDIOLOGY TODAY

may be the third largest read medical journal among physicians.

⁴ Applicant's predecessor (Slack Incorporated) owned a registration for CARDIOLOGY TODAY for "medical magazines." The registration was cancelled under Section 8 on September 10, 1991. Applicant is not claiming any rights in the mark based on its predecessor's use.

publication has been available since at least as early as 1998. The website for CARDIOLOGY TODAY also features "online seminars," although Mr. Roash states that that this service is still under development. Applicant promotes its newspaper by distributing free copies of the newspapers to cardiologists at meetings and conferences such as the annual meetings of the American College of Cardiology and the American Heart Association. Applicant's advertising is directed to pharmaceutical companies and their advertising agencies that place advertisements in, and pay for applicant's newspaper. According to Mr. LoPresti, the CARDIOLOGY TODAY newspaper ranks sixth in readership out of eighteen other publications in the cardiology field.

Applicant, in its brief, has not disputed opposer's priority. In any event, opposer has clearly established use of the designation CARDIOLOGY TODAY AND TOMORROW in connection with its seminars and the associated printed materials which predates applicant's constructive date of first use.

We turn then to a consideration of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue, including the similarity of the marks and the similarity of the goods. In re E.I. du Pont de Nemours & Co.,

476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding are discussed below.

We turn first to the parties' respective goods and services. Applicant contends in this regard that its medical newspaper is "dissimilar" (applicant's brief, p. 14) to opposer's CME seminars, that applicant's medical newspaper does not compete with CME seminars, and that the newspaper cannot be substituted for these seminars. It is clear that there are specific differences in the respective products and services. However, the question is not whether purchasers can differentiate the goods and services themselves but rather whether purchasers are likely to confuse the source of the goods and services. See, e.g., *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Thus, it is not necessary that the goods and services of the parties be similar or even competitive to support a finding of likelihood of confusion. It is sufficient if the respective goods and services are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

We find that medical newspapers and medical seminars are closely related media for disseminating information. Moreover, applicant's newspapers and opposer's seminars concern the same subject matter and serve the same general purpose, that is, to inform and educate cardiologists about various issues including current news and the latest developments relating to their field. As Ms. Erickson points out, in addition to seminars, cardiologists stay abreast of current developments in their field through journals and other medical periodicals. In fact, opposer and applicant are engaged in both activities, that is, both organizations publish medical periodicals and they both conduct medical seminars and conferences. There is also evidence that applicant intends to expand its operations into "online" seminars under the CARDIOLOGY TODAY mark in the near future. Thus, it would be reasonable for purchasers to expect medical seminars and medical publications such as applicant's newspaper to emanate from, or to be sponsored by the same organization.

Moreover, contrary to applicant's claim, there is some overlap in the marketing of these medical seminars and medical newspapers as well as the channels of trade in which they are provided. Both goods and services are promoted over the Internet and, as of late, are also provided over the Internet.

In addition, they are both promoted at professional meetings and conferences, and cardiologists may even expect to see opposer's CME seminars to be advertised in at least the online version of applicant's newspaper. In any event, any asserted differences in trade and marketing channels for these goods and services becomes less significant when we consider that both applicant's newspapers and opposer's seminars are intended to reach precisely the same individuals, every cardiologist located in the United States.

Thus, the question is whether the marks used in connection with the respective goods and services is likely to cause confusion. As a preliminary matter, there seems to be some dispute as to what opposer's mark is. Opposer has asserted rights based on use of the word mark CARDIOLOGY TODAY AND

TOMORROW as a single typed phrase.⁵ Applicant contends that opposer's common law rights in the mark reside in the

⁵ As noted earlier, applicant submitted certified copies of the file contents for two registrations owned by opposer. These registrations, which issued after the opposition was filed, cover the marks CARDIOLOGY TODAY AND TOMORROW in typed form. One registration is for cardiology seminars and the other is for printed instructional materials in the field of cardiology. Applicant is relying on this evidence to show that the Examining Attorney did not cite applicant's involved application against opposer's later-filed applications. Opposer, contrary to its apparent belief, is not entitled to rely on

designation as two separate terms, CARDIOLOGY and TODAY AND TOMORROW, rather than as a unitary phrase. Applicant maintains that CARDIOLOGY is "separated from TODAY AND TOMORROW by type style and/or a colon and/or a line" and that such separations are "significant." (Applicant's brief, p.2, fn 1). Opposer's mark is used in a variety of formats, often within the same publication. For example, on the cover of opposer's 1995 program brochure, the word CARDIOLOGY is positioned above TODAY AND TOMORROW and a line is drawn between the two terms. At another point in the brochure, the word CARDIOLOGY is displayed in upper case block letters followed on the same line by a colon and the words TODAY AND TOMORROW in lower case letters with capital T's. On a different page, TODAY AND TOMORROW is displayed on the same line and in the same style of lettering as CARDIOLOGY but in smaller versions of those letters. In yet another format, the entire phrase appears on the same line in the same type size and style. The colon is there, but it is barely visible and the italic lettering seems to be used only to set the mark off

these registrations to support its claimed rights in the typed version of the mark or any rights in the mark based on these registrations for that matter since opposer has neither submitted status and title copies of these registrations (the certified copies of record do not indicate status and title) nor introduced such registrations by way of testimony made by a witness having knowledge

from the text. We find that this latter use of CARDIOLOGY TODAY AND TOMORROW is essentially the equivalent, in its commercial impression, of a typed version of the mark.

Even where the terms CARDIOLOGY and TODAY AND TOMORROW appear on separate lines, or in uses where the colon is more noticeable, the mark as a whole, still conveys a single, unitary impression.⁶ For example, since a colon is used to direct attention to what follows it, the colon in this mark serves to join the terms CARDIOLOGY and TODAY AND TOMORROW rather than to separate them. The point is that in each format, the visual and connotative impression of the words is that of a composite phrase, and not just the individual terms TODAY AND TOMORROW and CARDIOLOGY.

Turning to a comparison of the respective marks, we find that, considered in their entireties, CARDIOLOGY TODAY is substantially similar to CARDIOLOGY TODAY AND TOMORROW. Applicant's mark incorporates a very significant portion of opposer's mark. The word CARDIOLOGY may be generic and is in fact disclaimed in applicant's mark. However, it is well settled that the disclaimed material still forms a part of the mark and cannot be ignored in comparing the marks as a whole.

of the current status and title of the registrations. See Trademark Rule 2.122(d)(1) and (2).

⁶ However, there is no evidence that consumers would abbreviate opposer's mark to "CARDIOLOGY TODAY."

Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

The marks are visually similar even considering that the words "AND TOMORROW" do not appear in applicant's mark. Relying on Pfizer Inc. v. Cody John Cosmetics, Inc., 211 USPQ 64 (TTAB 1981), applicant contends that we should consider the "realities of the marketplace" and "consider the manner in which the marks appear to the public." (Applicant's brief, p.13). Applicant concludes that the exhibits showing the manner in which the parties actually display their marks demonstrates that confusion is not likely to occur. We disagree with these contentions. Applicant seeks to register its mark in typed form. This means that applicant is free to present its mark in a variety of forms and styles, including stylization similar to that used by opposer. Phillips Petroleum v. C.J. Webb, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971); and INB National Bank v. Metrohost, 22 USPQ2d 1585 (TTAB 1992). For example, if applicant were to emphasize CARDIOLOGY by depicting it in large, capital letters and to show TODAY in a smaller, lower case lettering, the two marks would appear even more similar. In fact, even when we consider the manner of actual use, we find that applicant's mark in at least one display, appears in a similar format to one of opposer's presentations of its mark. For example, on

applicant's web page, the word CARDIOLOGY appears in large block style letters and TODAY is depicted in smaller and more stylized lettering.

The two marks, when considered as a whole, also have similar connotations. Both marks suggest that the parties are providing news and information in the cardiology field. The wording AND TOMORROW suggests a slightly broader scope of information but it does not change the overall meaning the two marks convey. Keeping in mind that the comparison of marks is not made on a side-by-side basis and that recall of purchasers is often hazy and imperfect, the difference in these marks is not so significant as to eliminate the likelihood of confusion. See, e.g., HRL Associates Inc. v. Weiss Associates Inc., 12 USPQ2d 1819 (TTAB 1989). The customers for these goods and services are busy physicians who are inundated with resource materials. Upon encountering applicant's CARDIOLOGY TODAY mark for newspapers, they may not remember that the wording AND TOMORROW is part of opposer's mark or if they do recall the term, they may assume, in view of the similar meanings of the marks and the fact that they are used on closely related goods and services, that the CARDIOLOGY TODAY medical newspaper is simply an extension of, or somehow associated with or sponsored by the CARDIOLOGY TODAY AND TOMORROW medical seminar.

Applicant argues that opposer's mark, containing the generic term CARDIOLOGY combined with "highly suggestive words" (brief p.11), is entitled only to a narrow scope of protection. First, contrary to applicant's apparent contention, any alleged third-party uses of the generic word "cardiology" in otherwise dissimilar marks is irrelevant. Moreover, while the word CARDIOLOGY alone may be generic, the phrase as a whole is only suggestive of opposer's services. Applicant has introduced no evidence of third-party registrations or uses of similar marks in the relevant market or any other evidence to support its claim that registrant's mark is highly suggestive of the services or that it is entitled to only a narrow scope of protection. Further, opposer's evidence tends to show that the CARDIOLOGY TODAY AND TOMORROW program has achieved at least a moderate degree of recognition in the cardiology field and that the mark is in fact entitled to more than a narrow scope of protection.⁷

We also note that while the purchasers of these goods and services may be informed and sophisticated individuals, they are not necessarily knowledgeable about trademarks or sophisticated in distinguishing one trademark from another

⁷ Applicant argues that opposer has not established the "fame" of its mark, but opposer has made no such assertion. We note however, that as applicant points out, the renown of Mayo Foundation itself has not been established on this record, nor has opposer identified or

when the marks are as similar as those herein and cover closely related goods and services. See, e.g., *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). Furthermore, there is no evidence that these individuals are likely to exercise great care in purchasing these particular goods and services. Opposer's seminars are taken by cardiologists for required credit and they are relatively inexpensive, costing just \$20 for those individuals who request credit for the program and \$50 for those who wish to purchase a videotape of the program.

Applicant's newspaper is free and therefore no purchasing decision is being made.

Finally, we do not view the absence of actual confusion as significant in view of all the evidence indicating that confusion is likely. See, e.g., *On-Line Careline, Inc. v. America Online, Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000). In addition, evidence of actual confusion is difficult to come by, and considering that the parties' seminars and newspapers are either free or relatively inexpensive, if purchasers are generally satisfied with the quality of these products and services, they may not be likely to take time out from their busy medical practices to report any such

established the relationship, if any, between opposer and Mayo

confusion, or they may just incorrectly assume that the products and services emanate from the same source.⁸

In view of the foregoing, we conclude that purchasers familiar with opposer's medical seminars offered under the mark CARDIOLOGY TODAY AND TOMORROW would mistakenly believe that applicant's medical newspaper issued under the mark CARDIOLOGY TODAY was a product emanating from opposer or that the products and services were somehow associated with the same source.

DECISION: The opposition is sustained.

Clinic.

⁸ Applicant also believes that the Board should give "considerable weight" (applicant's brief, p.10) to the fact that the Examining Attorney did not cite applicant's CARDIOLOGY TODAY applications against opposer's later-filed applications. The Board, of course, is not bound by an Examining Attorney's prior determination as to registrability. See McDonald's Corp. v. McClain, 37 USPQ2d 1274 (TTAB 1995).